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tesa AG 661-WCG
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants : Uwe SCHUMANN, et al.
Serial No. : 09/698,404
Filed : October 27, 2002
For : PROCESS FOR CONTINUOUS MANUFACTURE OF SELF-ADHESIVE ARTICLES BY COATING INCOMING WEB-FORM MATERIALS WITH TWO-COMPONENT POLYURETHANES
Art Unit : 1734
Examiner : Sing P. Chan

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' BRIEF ON APPEAL PURSUANT TO 37 CFR § 1.192

Sir:

This is an appeal from the final rejection.

1. REAL PARTY IN INTEREST

The instant application is owned by tesa AG, record owner hereof.

2. RELATED APPEALS AND INTERFERENCES

The undersigned is not aware of any appeals, interferences, reexaminations, infringement actions or the like in any related applications.

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3. STATUS OF CLAIMS

The claims pending in this application are claims 1-8, and all of said claims are on appeal.

4. STATUS OF AMENDMENTS

The last amendment was that filed on July 24, 2002 (mailing date) and that amendment was entered. There are no outstanding amendments.

5. SUMMARY OF THE INVENTION

Each of the appealed claims relates to a novel process for the continuous production of self-adhesive articles, wherein a polyurethane-forming reactive mixture of polyol and isocyanate components are continuously applied to a first backing material which is coated with a pressure sensitive adhesive composition, the isocyanate and polyol reacting on the adhesive coated backing material to form a polyurethane composition and the resulting laminate passed through a heat tunnel wherein the polyurethane composition cures, and the laminate is then wound in a winding station.

Unlike the prior art processes, the laminate produced by the instant process can be wound up immediately after exiting the heat tunnel, without the requirement of allowing the polyurethane to complete a further hardening. This further hardening, which typically is required in the prior art, can take several days to accomplish in the prior art.

It is surprising that Appellants' laminate, with the cured out unhardened polyurethane, can be wound up without adverse effect.

6. ISSUES

The issues are

- A) Whether claims 1, 4, 5 and 7 are unpatentable under 35 USC 102(b) as being anticipated by Edenbaum et al (US 4,675,232).
- B) Whether claims 1-8 are unpatentable under 35 USC 102(e) as anticipated by Schumann et al (US 6,129,983).
- C) Whether claim 8 is unpatentable under 35 USC 103(a) as obvious over Schumann et al (US 6,129,983) in view of the so-called admitted prior art.

7. GROUPING OF CLAIMS

For each ground of rejection, the claims stand and fall together.

8. ARGUMENTS

- A) The rejection of claims 1, 4, 5 and 7 under 35 USC 102(b)
as anticipated by Edenbaum et al (US 4,675,232)

Edenbaum has nothing to do with the application of a reactive mixture of a polyol and an isocyanate to a backing, and reacting it on the backing to form a polyurethane.

The Examiner argues that although Edenbaum applies a dispersion of a prepolymer or polymer of polyurethane, this dispersion is still reactive. This begs the question, however. Whether or not the substance that Edenbaum applies is or is not "still reactive" is not the issue. The legal issue is whether or not Edenbaum applies the same composition as that recited in Appellants' claims. The fact is, he does not.

Appellants' composition is a reactive mixture of a polyol and isocyanate (Claims 1a, b, c). Appellants' polyurethane-forming reactive mixture, recited in part c of claim 1, is not just

any polyurethane-forming reactive mixture, it is the specific polyurethane-forming reactive mixture of the *polyol component and isocyanate component* recited in parts a & b of claim 1. This is different than that which is applied by Edenbaum. A "reactive polyurethane" (i.e., a prepolymer) is not the same thing as a reactive mixture of a polyol and an isocyanate. In addition, there is nothing in Edenbaum that would lead those skilled in the art to the application of a reactive mixture of a polyol component and an isocyanate component such as Appellants'.

Edenbaum therefore cannot possibly anticipate or suggest Appellants' claims, and the rejection of claims 1, 4, 5 and 7 under 35 U.S.C. 102(b) as anticipated by Edenbaum et al (US 4,675,232) should be reversed.

B) The rejection of claims 1-8 under 35 USC 102(e) as anticipated by Schumann (US 6,129,983)

Schumann does not disclose a continuous process, such as that claimed herein. The Examiner argues, however, that Schumann requires a continuous process, such as coating the backing after an in-line corona treatment, and cites to Col. 8, lines 11-17.

First of all, nothing in the language cited by the Examiner says anything at all about a continuous process.

Secondly, the language the Examiner refers to concerns the application of polyacrylate coating to the material that has already been coated with a polyurethane and stored for one week!

Thirdly, Appellants' claims say that it is the *polyurethane-forming reactive* mixture

itself that is continuously applied to the backing material...see part c of claim 1. Schumann does not teach, and the Examiner does not say Schumann teaches, anything at all about the **continuous application of a polyurethane-forming reactive mixture** to a backing.

The language cited by the Examiner, Col. 8, lines 11-17, must be read in the light of Col. 7, lines 55-65. From this language, the Examiner will see that, in a first step, Schumann produces a paste for the backing; and then applies the paste to a backing. Afterwards, the backing is dried and crosslinked (Col. 8, lines 2-10) **and then stored for one week!** Afterwards, the backing is coated on both sides.

The break of one week clearly shows that Schumann is not a continuous process! Schumann et al cannot therefore in any way be viewed as teaching or suggesting Appellants' novel process, and the rejection of claims 1-8 under 35 U.S.C. 102(e) as anticipated by Schumann et al (U.S. 6,129,983) should be reversed.

C) The rejection of claim 8 under 35 USC 103(a) as obvious over Schumann et al (US 6,129,983) in view of the so-called admitted prior art

The Examiner relies on the "admitted prior art" for a teaching of various dehesive media. The use of specific dehesive media in the Schumann process will not in any way overcome any of the differences discussed above. Certainly, the use of any particular dehesive material will not suggest the changes that would be required to go from Schumann's process to Appellants. Where, for example, does the Examiner see any suggestion to continuously apply a reactive mixture of a polyol and isocyanate to a backing? The answer is, of course, nowhere!

The rejection of Claim 8 under 35 U.S.C. 103(a) as obvious over Schumann et al in view of the so-called "admitted prior art" should accordingly be reversed.

9. CONCLUSION

Wherefore it is submitted that the final rejection is in error and should be reversed.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, appellant requests that this be considered a petition therefor. Please charge the required Petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess to our Deposit Account No. 14-1263.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

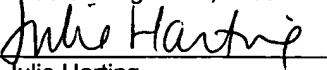
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By 
Julie Harting
Date August 18, 2003

10. APPENDIX

The claims are appeal read as follows:

Claim 1. A process for continuous production of self-adhesive articles, wherein

- a) essentially one polyol component is placed in a container A and
essentially one isocyanate component is placed in a container B,
- b) the polyol component and the isocyanate component are continuously supplied to and mixed in a mixer, to form a polyurethane-forming reactive mixture,
- c) the polyurethane-forming reactive mixture is continuously applied to a first backing material which is coated with a pressure-sensitive adhesive composition and moves optionally at a constant speed, the isocyanate component and polyol component reacting on the adhesive-coated backing material to form a polyurethane composition,
- d) the resulting laminate, comprising the first backing material, pressure-sensitive adhesive composition and polyurethane composition, is passed through a heat tunnel, in which the polyurethane composition cures,
- e) the laminate is wound in a winding station.

Claim 2. The process as claimed in claim 1, wherein a second backing material is applied to the polyurethane-forming reactive mixture on the first backing material and, optionally is peeled off after the heating tunnel.

Claim 3. The process as claimed in claim 2, wherein the second backing material is treated with a pressure-sensitive adhesive composition.

Claim 4. The process as claimed in claim 1, wherein upstream of the mixer there are further containers for catalysts, plasticizers, dyes and other additives, which optionally are introduced and added.

Claim 5. The process as claimed in claim 1, wherein the polyurethane-forming reactive mixture is applied onto the pressure-sensitive adhesive material.

Claim 6. The process as claimed in claim 2, wherein the first or second backing material used comprises a dehesive media.

Claim 7. A single- or double-sided self-adhesive tape obtained by a process as claimed in claim 1.

Claim 8. The process of claim 6 wherein said dehesive media is selected from the group consisting of release paper, release film, a woven, a nonwoven, film or an elastomer.